

REMARKS

This Amendment is filed in response to the Office Action mailed on February 1, 2006. All objections and rejections are respectfully traversed.

Claims 1-10 are currently pending.

Response to Election/Restriction Requirement

In Applicant's response filed on January 3, 2006, Applicant only withdrew claims 11-26. Applicant did not withdraw claims 2-6 as Examiner believes. Claims 2-6 depend on claim 1, which is a generic claim. Claims 2-6 only further limit claim 1, where claim 1 is in the same category as claim 7.

Applicant requests examination of claims 2-6.

Objection to Abstract

The Examiner objected to the Abstract because it exceeds the 150 word limit.

Applicant has filed an amended abstract to replace the original.

Claim Rejections – 35 U.S.C. §103

At paragraphs 3-4 of the Office Action, claims 1, 7-10 were rejected under 35 U.S.C. §103 as being unpatentable over DeFilippis et al., US Patent Application Publication No. 2003/02156886, published on Nov. 20, 2003, hereinafter DeFilippis, in view of Barber, US Patent No. 6,443,717, issued on Sept. 3, 2002, hereinafter Barber.

Applicant respectfully urges that DeFilippis is precluded under 35 U.S.C. 103(c) as a reference under 35 U.S.C. 103(a) against the present Application because DeFilippis and the present invention were both owned by MTI Microfuel Cells Inc. at the time that the invention was made.

The statute 35 U.S.C. 103(c) states as follows:

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

The present application was assigned to MTI Microfuel Cells Inc. by Assignment recorded at Reel/Frame 014927/0505 on January 26, 2004. DeFilippis was assigned to MTI Microfuel Cells Inc. by Assignment recorded at Reel/Frame 014355/0580 on August 7, 2003. The respective filing dates and other relevant dates regarding the present Application and the DeFilippis reference are summarized as follows:

Filing date of the present Application: June 27, 2003.

Filing date of cited art, DeFilippis: March 4, 2002.

Publication date of cited art, DeFilippis: November 20, 2003

Issue date of cited art, DeFilippis: Not patented yet

Pursuant to 35 U.S.C. § 102:

A person shall be entitled to a patent unless--

Section 102(a) states: “the invention . . . was patented . . . in this . . . country . . . before the invention thereof by the applicant”

DeFilippis does not qualify as prior art under 102(a) because the invention was invented by Applicant before patenting by DeFilippis, as Applicant’s filing date precedes patenting of DeFilippis and because DeFilippis is not issued as a patent yet.

Section 102(b) states: “the invention was patented . . . more than one year prior to the date of the application for patent in the United States”

DeFilippis has not issued as a patent yet.

Section 102(c) states: “he has abandoned the invention”

DeFilippis does not qualify as prior art under 102(c) because Applicant has not abandoned the present invention.

Section 102(d) states: “the invention was first patented or caused to be patented . . . in a foreign country prior to the date of the application for patent in this country on an application for patent . . . filed more than twelve months before the filing of the application in the United States”

DeFilippis does not qualify as prior art under 102(d) because the present invention was not filed in a foreign country before filing in the United States.

Accordingly, Applicant respectfully urges that DeFilippis qualifies as prior art only under 35 U.S.C. 102(e), 102(f), or 102(g), and therefore is legally precluded from serving as a reference under 35 U.S.C. 103(a) by operation of 35 U.S.C. 103(c).

Therefore, as the rejection to claims 1, and 7-10 hinges on DeFilippis, the claims should be now be allowable.

Additionally, the present invention, as set forth in claim 1, comprises in part:

1. A fluid controlling assembly for use in a direct oxidation fuel cell, which fuel cell has an anode chamber and a cathode chamber, the assembly comprising:

an adjustable component at least a portion of which is disposed within the cathode chamber of the fuel cell, and said component, when adjusted, *regulates the rate at which fluids travel into and out of the cathode chamber of the fuel cell.*

By way of background, Barber describes a variable valve timing approach to control compressors and expanders in a fuel cell. The system uses a rotating disc that contains slots, which are either aligned with the ports to connect or block the connection of the port.

Applicant respectfully urges that Barber does not teach Applicant's claimed novel *an adjustable component ...regulates the rate at which fluids travel into and out of the cathode chamber of the fuel cell.* In further detail, Applicant's claimed invention describes an adjustable component that regulates the rate at which fluids travel into and out of the *cathode chamber*. There is no description or suggestion in Barber of such an adjustable component in a cathode chamber, or elsewhere in the fuel cell.

Accordingly, Applicant respectfully urges that the Barber patent is legally insufficient to render the presently claimed invention obvious under 35 U.S.C. § 103 because of the absence in the cited patent of Applicant's claimed novel *an adjustable component ...regulates the rate at which fluids travel into and out of the cathode chamber of the fuel cell.*

DeFilippis has been disqualified as a reference, and Barber alone, for the reasons set forth above does not render Applicant's invention obvious, therefore, it is respectfully submitted that the claimed invention is patentable over the cited references.

All independent claims are believed to be in condition for allowance.

All dependent claims (including claims 2-6) are dependent from independent claims which are believed to be in condition for allowance. Accordingly, all dependent claims are believed to be in condition for allowance.

Favorable action is respectfully solicited.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,



Shannen C. Delaney
Reg. No. 51,605
CESARI AND MCKENNA, LLP
88 Black Falcon Avenue
Boston, MA 02210-2414
(617) 951-2500